

REMARKS

This paper is in response to the Office action dated November 3, 2006, where the Examiner has rejected claims 1 – 13 and 20 – 28, which remain pending in the present application with claims 1, 7, 23, and 24 being the independent claims. No claims have been amended, cancelled or added in this response. Reconsideration and allowance of pending claims 1 – 13 and 20 – 28 in view of the following remarks are respectfully requested.

A. Rejection of Claims 1 – 6 and 21 Under 35 USC §103

In the Office Action, claims 1 – 6 and 21 have been rejected under 35 U.S.C. 103(a) as unpatentable over U.S. Publication No. 2004/0005889 ("Shanahan") in view of U.S. Publication No. 2002/1023336 ("Kamada") and further in view of U.S. Patent No. 5,588,148 ("Landis"). The Office Action relies primarily on Shanahan as teaching the elements of the claimed invention and states that the combination of Shanahan with Kamada and Landis would have been obvious to a person of ordinary skill in the art. This rejection is traversed as follows.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a *prima facie* case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion

to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure.

1. Suggestion or Motivation to Combine

The Office Action cites Kamada at paragraphs 83 and 85 to justify the combination of Shanahan and Kamada "for the purpose of security and providing a dedicated storage area as taught by Kamada." The cited passages fail to properly motivate one skilled in the art.

The Shanahan reference is directed toward downloading digital information to a remote device. In contrast, the Kamada reference is directed toward providing server based storage for a remote device. Accordingly, Shanahan teaches providing data to a handset while Kamada teaches receiving data from a handset – these teachings oppose each other.

There are significant differences between providing data to a handset and receiving data from a handset. The mechanics of where the data is ultimately stored is a primary difference. The teachings of Shanahan require that the server allow a user to indicate what data to download to the handset and then the server must send that data to the handset for storage. In contrast, the teachings of Kamada require that the server store the data on behalf of the handset. The Office Action fails to reconcile these contrasting references and makes no attempt to explain or provide a citation that explains why one skilled in the art would be motivated to combine these radically different systems.

Furthermore, the Office Action cites Landis at column 3, line 55 as motivating the combination of Landis with Shanahan and Kamada "to include obtaining profile information for the wireless communication device, the profile information comprising a

data storage capacity of the wireless communication device for the purpose of optimization." This cited passage fails to properly motivate one skilled in the art in the manner suggested.

Like Kamada, the Landis reference teaches server based data storage for a wireless communication device. Importantly, the entire optimization motivation is wholly inadequate justification for the combination because the obtaining of profile information in addition to the other communications that are taking place under Shanahan and Kamada would make their communications less efficient because they would use more bandwidth. One skilled in the art, motivated by optimization would not be inclined to increase the amount of bandwidth required and increase the amount of data that is unnecessarily being sent between two device. To the contrary, the motivation would be exactly the opposite.

Because the Office Action has not cited any motivation taught by the references themselves to combine the diverse systems of Shanahan and Kamada, and because the Office Action has failed to cite any reasonable motivation to additionally combine Landis with Shanahan and Kamada, Applicant respectfully submits that the only logical connection between the references is the general concept of moving data over a wireless network, and that the cited prior art is only modified in retrospect, in light of the present invention. That is, the obviousness rejection is based upon the Applicant's own invention characterization, not any modification of Shanahan actually suggested by the references themselves. In general, the combination of references made in the §103(a) rejection appear to be the result of keyword searches as opposed to a true nexus of related ideas in the same field of art.

"Therefore, an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue....To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that would create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art reference for combination in the manner claimed." *In re Rouffet*, 47 USPQ2d 1453, 1457-1458 (1998).

"The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

2. Reasonable Expectation of Success

Further, the Examiner has not demonstrated that the modification of Shanahan with the contrasting teachings of Kamada and Landis points to the reasonable expectation of success in the present invention, which is the second requirement of the obviousness analysis. As previously stated, the teachings of Shanahan oppose the teachings of Kamada and Landis.

Shanahan teaches a system that stores information on the handset while Kamada and Landis both teach a remote data storage system where a handset stores data on a server. These references teach opposite techniques for data storage and to modify Shanahan with Kamada or Landis or both would require a wholesale change in

the basic operational principles of Shanahan. The Office Action fails to reconcile this fact and therefore the combination is improper.

For example, Shanahan contemplates that a user interacts with the server from a programmer device. The programmer device, according to Shanahan, is not a handset. Accordingly, Shanahan precludes any authentication of a user at the handset. Specifically, Shanahan states in paragraph 30 on page 3:

Although not shown in FIG. 2, programmer 30 preferably has a display screen and a data input device, such as a keyboard associated with it so that a user may, among other things, browse and select files, monitor file transfers, and ensure that device 20 has properly received the selected files.

This passage demonstrates that Shanahan does not contemplate a user at the handset being authenticated by the server. Any modification of Shanahan to include such functionality would require a significant shift away from the basic operating principles of Shanahan and the Office Action fails to provide any teachings in the references that suggest that such a radical modification of Shanahan is likely to be successful.

3. Combined References Must Teach All Claim Limitations

With respect to the third prong of an obviousness analysis, the combination of the references does not yield all the limitations of the claimed invention. Specifically, claim 1 requires that the connectivity toolkit server obtains profile information for a connecting wireless communication device and that the profile information includes a data storage capacity for the wireless communication device and also includes identification information for a portion of the server hosted data storage area that is reserved for the wireless communication device.

The Office Action cites Kamada as teaching that the profile information includes identification information for a portion of the server hosted data storage area that is reserved for the wireless communication device. Nowhere in the cited passages (¶¶ 76, 77, and 81) does Kamada teach this. In fact, Kamada provides no discussion at all that teaches obtaining profile information from the wireless communication device, as required by the claimed invention in claim 1. Kamada merely teaches a username and password challenge to authenticate a user. Accordingly Kamad fails to teach this aspect of the claimed invention.

Summary

In summary, the Office Action cites no passages in the references themselves that suggest or provide any motivation to combine the teachings of Shanahan with Kamada and Landis. Further, the Examiner has not demonstrated that the modification of the cited the prior art reference points to the reasonable expectation of success in the present invention, which is the second requirement of the obviousness analysis. Finally, the combination of Shanahan, Kamada, and Landis fail to teach the invention claimed in independent claim 1. Thus, the combination of Shanahan with Kamada and Landis fails to make the claimed invention obvious and Applicant respectfully requests that the rejection of independent claim 1 and its respective dependent claims be withdrawn.

B. Rejection of Claims 7 – 13 and 23 – 28 Under 35 USC §103

In the Office Action, claims 7 – 13 and 23 – 28 have been rejected under 35 U.S.C. 103(a) as unpatentable over Shanahan in view of Kamada. The Office Action relies primarily on Shanahan as teaching the elements of the claimed invention and

states that the combination of Shanahan with Kamada would have been obvious to a person of ordinary skill in the art. This rejection is traversed as follows.

1. Suggestion or Motivation to Combine

As described above, the teachings of Shanahan and Kamada directly oppose each other because Shanahan teaches providing data to a handset while Kamada teaches receiving data from a handset. However, the Office Action states that it would have been obvious to modify Shanahan to include a reserved data storage area "for the purpose of improving upon the limited storage capacity as taught by Kamada in paragraph 001."

This motivation profoundly fails because the entire focus of Shanahan is to program information into the wireless communication device. Any suggestion that one skilled in the art would somehow be motivated to modify Shanahan such that information was programmed somewhere other than into the wireless communication device is the result of impermissible hindsight. Therefore, one skilled in the art would not be motivated to combine Shanahan with any teachings from Kamada, whose application is limited by its technical field (see the cited paragraph 001) to portable data terminals with limited internal storage capacity.

Because the Office Action itself has not cited proper motivation taught by the references themselves to combine the diverse systems of Shanahan and Kamada, Applicant respectfully submits that the cited prior art is only modified in retrospect, in light of the claimed invention that the only logical connection between the references is that they both contemplate the moving data over a wireless network. Accordingly, because the obviousness rejection is based upon the Applicant's own invention

characterization, and not any properly motivated modification of Shanahan, the rejection fails to make a *prima facie* case for obviousness of independent claim 7.

With respect to independent claims 23 and 24, the Office Action cites the same motivation from Kamada in support of the modification of Shanahan by Kamada. This cited motivation additionally fails.

2. Reasonable Expectation of Success

The Examiner has not demonstrated that the modification of Shanahan by the opposite teachings from Kamada points to the reasonable expectation of success in independent claims 7, 23, and 24, which is the second requirement of the obviousness analysis. To modify Shanahan as suggested in the Office Action would require a fundamental change in the basic operation of Shanahan.

3. Combined References Must Teach All Claim Limitations

With respect to the third prong of an obviousness analysis, the combination of the references does not yield all the limitations of independent claims 7, 23, and 24. Specifically, claim 7 requires that the utility programs are executed on the wireless connectivity toolkit server and that the wireless communication device is allowed access to upload and download files to and from a portion of the data storage area on the wireless connectivity toolkit server that is reserved for the wireless communication device. Neither Shanahan nor Kamada teach these limitations. Importantly, in Kamada, the server apparatus remains in control of the server based storage. Kamada teaches that the server routes files obtained by a user of the handset to a server based storage area. The handset in Kamada is not allowed upload access to this storage area. Kamada teaches that only the server accesses this storage area, which is used to temporarily house files until they expire. This does not teach the claimed invention.

Additionally, with respect to independent claims 23 and 24, neither Shanahan nor Kamada even remotely contemplate the claimed invention. Claims 23 and 24 are directed toward an embodiment of the invention whereby two separate devices share access to a portion of the data storage area reserved for the wireless communication device over separate network connections to the server.

The Office Action relies primarily on Shanahan in the rejection of claims 23 and 24, however Shanahan teaches the programming of information into the remote device. Shanahan is nowhere near contemplating shared access to a portion of a server based data storage area reserved for the wireless communication device by two separate devices over two separate network connections to the server. The claimed invention in claims 23 and 24 is clearly not taught by Shanahan and Kamada does not remedy the failings of Shanahan in this regard, as recognized in the Office Action. Accordingly, independent claims 23 and 24 are presently in condition for allowance and a notice of allowance is respectfully requested for at least claims 23 and 24 and their respective dependent claims.

Summary

In summary, the Office Action cites no proper motivation to modify the teachings of Shanahan with the opposite teachings of Kamada. Further, the Examiner has not demonstrated that the modification of the cited the prior art reference points to the reasonable expectation of success in the claimed inventions of independent claims 7, 23, and 24, which is the second requirement of the obviousness analysis. Finally, the combination of Shanahan and Kamada fail to teach the invention claimed in independent claims 7, 23, and 24. Thus, the combination of Shanahan with Kamada fails to make the claimed invention obvious and Applicant respectfully requests that the

rejection of independent claims 7, 23, and 24 and their respective dependent claims be withdrawn and a notice of allowance be issued.

C. Rejection of Claims 22 Under 35 USC §103

In the Office Action, claim 22 has been rejected under 35 U.S.C. 103(a) as unpatentable over Shanahan in view of Kamada in further view of Landis and in further view of U.S. Publication No. 2001/0053708 ("Sugiyama"). The Office Action relies on the rejection of claim 1 for the element of claim 22 and states that the addition of Sugiyama would have been obvious to a person of ordinary skill in the art. This rejection is traversed as follows.

1. Suggestion or Motivation to Combine

In the Office Action, paragraph 007 of Sugiyama is cited as providing one skilled in the art with motivation to combine Sugiyama with the other cited references "for the purpose of simplifying operations." The cited passage from Sugiyama provides no such motivation. The cited passage merely states:

[0007] In addition, some of such portable telephones each has execution keys dedicated to additional functions which are supposed to be often used, for example, an incoming-call sound silencing function, and executes the additional functions in response to pushing of the execution keys. However, it is not sure that all users often use the additional functions, which deteriorates the operability.

Additionally, requiring the compressing and uncompressing the menu of utilities as required by claim 22 does not simplify operations. It makes operations more complicated both on the server and on the wireless communication device. Accordingly the cited motivation fails.

2. Reasonable Expectation of Success

Further, the Examiner has not demonstrated that the modification of the cited the prior art reference points to the reasonable expectation of success in the claimed invention in claim 22, which is the second requirement of the obviousness analysis. As previously stated, to modify Shanahan as suggested in the Office Action with respect to independent claim 1 (from which claim 22 depends) would require a fundamental change in the basic operation of Shanahan.

3. Combined References Must Teach All Claim Limitations

With respect to the third prong of an obviousness analysis, the combination of the references does not yield all the limitations of claim 22, for the reasons set forth with respect to claim 1 and also because Sugiyama does not teach the limitations in claim 22. The Office Action cites paragraphs 0008 – 0012 as teaching the step of compressing the menu of available connectivity toolkit utilities, wherein the menu is uncompressed by the wireless communication device prior to being displayed. However, a close review of these paragraphs reveals that Sugiyama nowhere even discusses compression. The cited paragraphs state:

[0008] In view of the foregoing, an object of this invention is to provide a portable telephone which can execute a desired function with simple operations.

[0009] The foregoing object and other objects of the invention have been achieved by the provision of a portable telephone which can execute a function selected from hierarchically structured menus, comprises execution keys for instructing to execute functions, a function assigning means for assigning a desired function to an execution key, and a function executing means for executing a function assigned to an execution key.

[0010] Functions selected by a user from hierarchically structured menus are assigned to dedicated execution keys and the functions, which are assigned to the execution keys, are executed in response to the pressing of the execution keys, so that the functions can be executed with simple operations, regardless of the hierarchies which the functions are belong to.

[0011] Further, in the present invention, execution keys are provided next to a display means for displaying various information, and symbols representing the functions assigned to the execution keys are displayed next to the execution keys, which allows a user to easily and correctly recognize the functions assigned to the execution keys.

[0012] The nature, principle and utility of the invention will become more apparent from the following detailed description when read in conjunction with the accompanying drawings in which like parts are designated by like reference numerals or characters.

Nowhere in these cited paragraphs does Sugiyama discuss compression.

Accordingly, Sugiyama fails to teach the required compression and claim 22 is in condition for allowance.

Summary

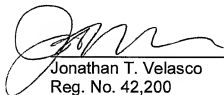
In summary, the Office Action does not cite any proper motivation for combining Sugiyama with the other cited references, the Office action has not demonstrated that the combination of Sugiyama with the other cited references points to the reasonable expectation of success in claim 22, and the combination of references fail to teach the claimed invention in claim 22. Thus, the Office Action fails to establish a *prima facie* case of obviousness for claim 22 and Applicant respectfully requests that the rejection be withdrawn.

D. Conclusion

For all the foregoing reasons, allowance of claims 1 – 13 and 20 – 28 pending in the present application is respectfully requested. If necessary, applicant requests under the provisions of 37 CFR 1.136(a) to extend the period for filing a reply in the above-identified application and to charge the fees for a large entity under 37 CFR 1.17(a). The Director is authorized to charge any additional fee(s) or any underpayment of fee(s) or credit any overpayment(s) to Deposit Account No. 50-3001 of Kyocera Wireless Corp.

Respectfully Submitted,

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